

REMARKS

Claims 1-7, 9, 11-24, 26-30, and 33-38 are pending in the application.

Claims 1-7, 9, 11-24, 26-30 and 33-38 stand rejected.

Claims 1, 9, 11, 17, 23, 26, 28, 29, and 35 have been amended. Support for these amendments can be found on page 13 and on Figures 6B and 7 of the specification, for example.

Claim 39 has been added.

Formal Matters

Unless otherwise specified in the below discussion, Applicants have amended the above-referenced claims in order to provide clarity or to correct informalities in the claims. Applicants further submit that, unless discussed below, these amendments are not intended to narrow the scope of the claims. By these amendments, Applicants do not concede that the cited art is prior to any invention now or previously claimed. Applicants further reserve the right to pursue the original versions of the claims in the future, for example, in a continuing application.

Applicants note that while the Office Action indicates that claims 1-7, 9, 11-24 and 26-38 are pending and are rejected, it is the case that claims 1-7, 9, 11-24, 26-30, and 33-38 are actually pending due to the previous cancelation of claims. The following remarks account for this discrepancy.

*Rejection of Claims under 35 U.S.C. §103*Claims 1-7, 9, 12-24, 26-30, and 33-38

Claims 1-7, 9, 12-24, 26-30, and 33-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hack, et al., U.S. Publication No. 2003/0187675 (“Hack”), in view of SAP.com, 2002 (“SAP.com”). Applicants offer amendments and respectfully traverse this rejection.

Cited Sections of Hack and SAP.com Fail to Teach Information Concerning Organization Performance with Respect to Each of the Business Challenges

Regarding independent claim 1, the Office Action cites ¶ [0023] of Hack as teaching the limitation of receiving user-specified information pertaining to one or more business challenges of an organization. *See* Office Action, p. 2. The Office Action equates the teaching in Hack that a user “may select a Business Goal such as ‘reducing operating costs’ or ‘lowering working capital’” with this limitation. However, as amended, independent claim 1 requires that “the user-specified information comprises information concerning the performance of the organization with respect to each of the one or more business challenges.” Since the mere selection of a “Business Goal” fails to “comprise information concerning the performance of the organization with respect to each of the one or more challenges,” Applicants assert that ¶ [0023] fails to teach this limitation. Even if Hack’s “Business Goal” were comparable to the “business challenge” recited in claim 1 (a point Applicants do not concede), the mere selection of a business goal not only fails to show, teach, or suggest information concerning the performance of a business with respect to that goal, but also fails to comprise information concerning the performance of *each of* the one or more “Business Goals.”

In addition, Applicants recognize that SAP.com states that a user “simply answers a few questions about [a] company’s industry, financial performance, and e-business maturity.” However, regardless of such statement’s infirmities, SAP.com completely fails to recognize the claimed business challenge, and certainly fails to provide any teaching whatever that its “financial performance” data is somehow information with respect to a business challenge. Given the Office Action’s equating Hack’s “Business Goals” with the business challenges of claim 1, this would require SAP.com to teach that its “financial performance” data is somehow comparable to Hack’s “Business Goals.” Hack and SAP.com clearly fail to teach such concepts for at least the reason that SAP.com and Hack fail to acknowledge any concepts disclosed by the other. Further, even if SAP.com’s “financial performance” data were information with respect to any kind of organization performance (a point Applicants do not concede), SAP.com fails to teach that such data might be given with respect to *each* of the one or more business challenges, as recited in claim 1.

Thus, for at least the reason that neither the cited sections of Hack nor SAP.com teach, either alone or in combination, that “the user-specified information comprises information concerning the performance of the organization with respect to each of the one or more business challenges,” Applicants respectfully request the reconsideration and withdrawal of the rejection against independent claim 1.

SAP.com Fails to Teach Estimating the Benefits of Addressing Hack’s Goals

In addition, regarding independent claim 1, the Office Action asserts that “SAP.com discloses a value calculator that ‘estimates benefits that are to be gained by the organization when the one or more business challenges are successfully addressed.’ *See* Office Action, p. 3. The Office Action alleges that the estimating cited in independent claim 1 is equivalent to

SAP.com's putative estimating of the benefits of implementing SAP products. *Id.* However, the Office Action also equates the business challenges recited in claim 1 with the Business Goals of Hack. The Office Action states that Hack's "business goals are [the] business challenges [of claim 1]." *See* Office Action, p. 1. Thus, according to the interpretation of Hack asserted by the Office Action, it is the case that, in order for SAP.com to teach the estimation of benefits gained when business challenges are addressed, SAP.com must teach the estimation of benefits gained when Hack's Business Goals are addressed.

However, Hack states that its Business Goals are items such as "reducing operating costs" and "lowering working capital." *See* ¶ [0023] of Hack. Thus, according to the interpretation of Hack offered by the Office Action, it must be the case that SAP.com teaches the estimation of benefits gained when goals such as "reducing operating costs" and "lowering working capital" are addressed. However, SAP.com fails to teach this. Instead, according to the Office Action, SAP.com teaches estimating the benefits of implementing SAP products. *See* Office Action, p. 3. Applicants submit that it would be unreasonable to interpret the Business Goals of Hack as in any way including the implementation of anything comparable to SAP's products.

Thus, for at least the additional reason that SAP.com fails to teach estimating the benefits of addressing Hack's Business Goals, as is required by the interpretation of Hack offered by the Office Action, Applicants respectfully request the reconsideration and withdrawal of this rejection against independent claim 1.

No Motivation to Combine

Further, regarding independent claim 1, the Office Action asserts that

it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the business process valuation tool of Hack et al. to include the estimation and value calculator as taught by SAP because it would provide another way for the user to determine the best process to implement in their company and to evaluate the usefulness of the implementation.

See Office Action, p. 4. However, SAP.com's calculator would not, in fact, "provide another way for the user to determine the best process to implement in their company." As discussed above, the Office Action states that SAP.com's calculator merely estimates the benefits of implementing SAP products. Thus, it appears that SAP.com's calculators are merely tools to aid in the sales of SAP.com's products, such as SAP.com's mySAP CRM. As such Applicants can find no evidence that SAP.com's calculators would provide a means of determining "the best" process to implement, or optimizing a company's systems or processes in any way. SAP.com contains, for example, no teaching that its calculators compare the benefits that can be obtained by use of SAP.com's products with either other comparable products, or with other distinct processes or types of processes.

Thus, for at least the additional reason that the motivation to combine provided by the Office Action relies upon a factual error, Applicants respectfully request the reconsideration and withdrawal of this rejection against independent claim 1.

Rationale for Combining SAP.com with Hack is Conclusory

Finally, as reiterated in MPEP 2141(III), the Supreme Court has stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness.”” *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (2007). Since SAP.com fails to provide any teaching concerning the specifics of the “few questions” that are answered by users, or the methods, means, processes, or systems employed by SAP’s calculators, it is not clear whether there is a reasonable expectation of successfully “modify[ing] the business valuation tool of Hack et al. to include the estimation and value calculator as taught by SAP” in order to “provide another way for the user to determine the best process to implement in their company and to evaluate the usefulness of the implementation,” as suggested on pp. 3-4 of the Office Action. Thus, the Office Action has attempted to sustain its rejection with a mere conclusory assertion. The Office Action has merely concluded that it is reasonable to expect that such a combination could be successful without providing either an articulated reasoning or a rational underpinning to this effect. Indeed, SAP.com provides so few details that it appears that no rational underpinning based upon SAP.com alone could be provided.

Thus, for at least the reason that the rejection has been supported with a mere conclusory assertion, Applicants request the reconsideration and withdrawal of this rejection. If, however, the Examiner desires to continue use of SAP.com in combination with Hack, Applicants request that a rational underpinning for the combination be provided in the form of additional references supporting the expectation of the successfulness of the combination or, at least, in the form of the taking of the appropriate official notice(s).

Request for Reconsideration and Withdrawal of Rejection Against All Claims

Since remaining independent claims 17, 23, 26, 28, and 35 have been amended to contain similar limitations as independent claim 1 and since similar reasons have been given to support the rejection of these claims (see Office Action, pp. 4, and 9-10), Applicants respectfully request the reconsideration and withdrawal of this rejection against all claims, for at least these reasons.

Additional Reasons for Allowing Dependent Claims 2, 18, and 24

However, Applicants assert an additional reason for the allowability of claims 2, 18, and 24. The Office Action rejects these claims based upon the assertion that since ¶ [0024] of Hack teaches that the “user may rank [the] relative importance of each business scenario” that Hack teaches the claimed element of “receiving a user-specified ranking of an organization performance with respect to each business challenge in the list.” However, Applicants point out that it is clear that a ranking of *importance* is not the same thing as a ranking of *performance*. Thus, for at least the additional reason that the cited sections of Hack fail to teach a ranking of organization performance, Applicants respectfully request the reconsideration and withdrawal of the rejection against claims 2, 18, and 24.

Claim 11

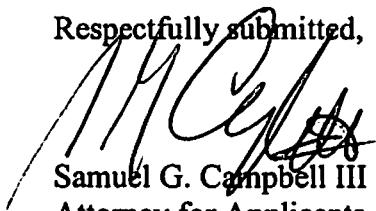
Claim 11 stands rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Hack, et al. in view of Spangenberg et al. U.S. Publication No. 2004/0260585 (“Spangenberg”). *See* Office Action, p. 13. Applicants respectfully traverse this rejection and respectfully request its reconsideration and withdrawal for at least the reason that claim 11 depends upon allowable base claim 1.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5089.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to deposit account 502306.

Respectfully submitted,


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